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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,046	01/13/2000	Antonio Gigola	6557	6489

7590 07/02/2003

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1323 Alliance Building  
ROCHESTER, NY 14604

EXAMINER
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CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 07/02/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/482,046

Applicant(s)

GIGOLA, ANTONIO

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-17 is/are pending in the application.
- 4a) Of the above claim(s) 10-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____.                                   |

## **RESPONSE TO AMENDMENT**

### ***REJECTIONS REPEATED***

1. The 35 U.S.C. 103(a) rejection of claim 7 over Munters (3,415,502) in view of Holmberg et al. (3,963,810) is repeated for reasons previously of record in paper #12, pages 3-4, paragraph #6.

Munters discloses a contact body or exchanger for cooling towers comprising a plurality of layers of sheets bearing against one another (col. 1, lines 12-51). The contact bodies comprise thin layers or sheets which preferably all have folds or corrugations crossing one another in adjacent layers. Preferably the folds are substantially formed following a sine curve or smoothly rounded (non-rectilinear undulated channels) between ridges and depressions (col. 3, lines 54-59). The contact body or exchanger shown in figure 2 has different angles of inclination (being of different mutual alternating inclination) of the corrugations or folds in every second layer (col. 4, lines 3-14). The layers may be glued together at points of contacts by means of a suitable bonding agent, such as contact glue (col. 3, lines 63-65). From figure 2 it can be seen that the points of contact are at the channel crests of adjacent sheets in contact with each other at spaced points.

Munters fails to disclose that the filling members are made of cardboard.

Holmberg discloses a contact body for use in cooling towers and heat exchangers comprising sinusoidal-shaped/corrugated contact plates made of metal, plastics, or impregnated cardboard (col. 1, lines 4-28).

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to use impregnated cardboard as the material for the filling members in Munters because Holmberg shows that plastics, metals, and impregnated cardboard are equivalent for their use in the art of cooling tower contact bodies and the selection of any of these known equivalents would be within the level of ordinary skill in the art.

2. The 35 U.S.C. 103(a) rejection of claims 8 and 9 over Munters (3,415,502) in view of Holmberg et al. (3,963,810) is repeated for reasons previously of record in paper #12, pages 4-5, paragraph #7.

Munters and Holmberg disclose all the limitations of the instant claimed invention except for the different configurations of the channels.

It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Also, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape, which would have been unforeseen to one of ordinary skill in the art.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape/configuration of the channels. One skilled in the art would have been motivated to change the shape/configuration of the channels depending on the how many times the user wants to redirect the flow and where the inlet and outlet flows are to be directed. Further evidence of known channel configurations can be seen in patents 3,111,982, 3,216,494, 3,757,857, and 4,732,713.

### ANSWERS TO APPLICANT'S ARGUMENTS

3. Applicant's arguments filed in paper #13 regarding the 35 U.S.C. 103(a) rejections over Munters (3,415,502) in view of Holmberg et al. (3,963,810) have been carefully considered but are deemed unpersuasive.

Applicant disagrees with the Examiner's position that Holmberg shows that plastics, metals, and impregnated cardboard are equivalent for their use in the art of cooling tower contact bodies. Applicant specifically argues that the PTO's position concerning the equivalency of plastic and cardboards is misplaced and that Holmberg nowhere provides any suggestion that plastics and cardboard are or can be equivalent in their physical and mechanical characteristics.

First, the Examiner has taken the position that metal, plastics, and **impregnated** cardboard are equivalent for their use in the art of cooling tower contact bodies. Substitution of equivalents requires no express motivation as long as the prior art recognizes the equivalency. *In re Fount* 213 USPQ 532 (CCPA 1982); *In re Siebentritt* 152 USPQ 618 (CCPA 1967); *Graver Tank & Mfg. Co. Inc. v. Linde Air Products Co.* 85 USPQ 328 (USSC 1950). Also, the selection of a known material based on its suitability for its intended use provides a *prima facie* case of obviousness *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). Holmberg recognizes that metal, plastics of impregnated cardboard can be used interchangeably as contact bodies in heat exchangers. Since these materials can be used interchangeably there is enough evidence to support a case of *prime facie* obviousness absent evidence showing that the prior art recognized equivalents are not capable of being use in combination with another piece of prior art. Furthermore, Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and §

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2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) (“An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.”). See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration.

Applicant further argues that the combined teachings fail to provide any expectation of success in being able to form a panel of claim 7. As stated above, substitution of equivalents requires no express motivation as long as the prior art recognizes the equivalency. Furthermore, reasonable expectation of success is found in the fact that these materials are art recognized equivalents barring evidence showing that the prior art recognized equivalents are not capable of being use in combination with another piece of prior art.

Applicant also argues that cardboard is not extensible and prior art techniques useful for forming channels in extensible materials would cause the cardboard to tear. First, the arguments of counsel cannot take the place of evidence in the record. Second, Holmberg discloses **impregnated** cardboard, not just cardboard. Impregnated cardboard would offer added strength and extensibility over mere cardboard.

### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139.

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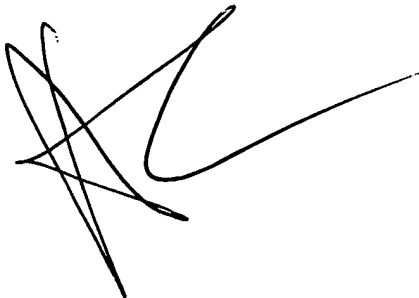
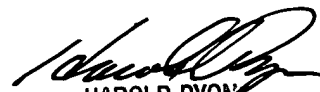
The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

7/1/03

A large, stylized handwritten signature in black ink, possibly reading 'ac', is written over the date '7/1/03'.A handwritten signature in black ink, likely of Harold Pyon, is written above the printed name.

HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

7/1/03